

REMARKS

In light of the above-amendatory matter and remarks to follows, reconsideration and allowance of this application are respectfully requested.

Claims 1-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al. (Downing) (US Patent 5,963,647) in view of Risafi et al. (Risafi) (US Patent 6,473,500). Applicant respectfully traverses this rejection for the reasons discussed below.

As correctly set forth by the Examiner, the Downing patent pertains to transferring funds from a customer to a recipient by first depositing by the customer a sum of money to a money-transfer company. The customer then supplies (e.g., via telephone) the recipient with a secret code or password to enable the recipient to access the funds. (col. 5, lines 16-18; col. 7, lines 6-17). The recipient uses a terminal, such as a Customer Activated Terminal (CAT, which is a special type of automated terminal machine – ATM) to enter the secret code (i.e., the password supplied by the customer to the recipient), along with the recipient's name to obtain the money deposited by the customer (col. 7, lines 29-41).

It Would NOT Be Obvious to Modify Downing As Proposed by The Examiner

While Downing teaches the foregoing process, the Downing patent presents this process as a money-transfer solution that enables “cardless withdrawal” by customers and non-customers, as set forth on col. 3, lines 40-47. Indeed, problems encountered by prior art processes as disclosed in the Downing patent and which are stated as being overcome by the Downing patent invention is (1) the problem of requiring “a recipient to locate an office which is open and which is capable of

receiving transfers;” and (in other prior art systems) (2) the problem of having “a card or equivalent means which permits the recipient to access an ATM or equivalent terminal” (col. 3, lines 1-13), where the problems encountered with attempting to utilize ATM cards in various foreign countries is discussed in the Background section of this patent. The Downing patent proposes a process that expressly does not use an ATM card or equivalent to withdraw money from an automated machine. Hence, one of ordinary skill in the art reading the Downing patent would be taught away from any modification that incorporates the utilization of ATM-like cards and, further, that requires the recipient to go to an open office to facilitate the money transfer. The present invention, on the other hand, employs a device, such as an ATM card, and further employs the utilization of distributors that activate such a device before providing it to the recipient who then can withdraw money at an automated machine using the activated device. Thus, without even considering the Risafi patent cited by the Examiner, the teachings of the Downing patent strongly support the position that it would not have been obvious to one of ordinary skill in the art to modify the invention disclosed in the Downing patent to produce applicant’s claimed invention.

Notwithstanding the foregoing, we now consider the teachings of the Risafi patent, which was relied upon by the Examiner to allegedly disclose those features of applicant’s claimed invention that are not taught by Downing. In the office action, the Examiner acknowledges that Downing fails to teach applicant’s claimed intermediate steps of receiving a money pick-up device from a distributor, and having that money-pickup device activated so that it may be used at a money dispensing

machine. To cure this deficiency, the Examiner relies upon Risafi to allegedly teach these intermediate steps.

The Risafi Patent discloses a system and method for using a prepaid card in which a consumer (note, not a “recipient” as that term is defined in the present invention) interacts with an agent distributing cards, the consumer selects a PIN, the card is then activated and the consumer may use it at a money-dispensing terminal. (col. 3, line 54 – col. 4, line 16). Thus, with respect to the process of transferring money from one person (a “customer”) to a second person (a “recipient”), the portions in Risafi relied upon by the Examiner actually pertain to activities that occur at the sender’s (customer’s) location (i.e., the sender interacts with an agent and the sender receives the card from the agent). To further support this assessment of Risafi, Risafi discusses employing the disclosed prepaid card for transferring money from a sender to a beneficiary, initially in col. 9, lines 51-57 and then in col. 19, lines 28-46.

Col. 9, lines 51-57 recites,

The card can also be used to transfer money, much as a wire transfer is accomplished today. A transferor adds value to a card account, and a second card having access to the same account is delivered to the transferee, perhaps in a different country. After the transferee learns of the PIN from the transferor, the transferee is then also able to access the value in the card account.

Col. 19, lines 28-45 recites,

A fourth application is using a prepaid card for transferring money from a sender to a beneficiary. In this application, a money transfer card is sold by prepaid card issuers or their agents in the sender's country, where the sender adds value to the card account. Another card is delivered to the beneficiary, who is likely in a different country, and who is able to make withdrawals at ATMs or purchases at POS

terminals. As illustrated in FIG. 10c, in step. 1072, the sender purchases card 100 as described in FIG. 4. Alternatively, if the sender already owns a card, the sender can reload the current card's account with the amount of value to be transferred. In step 1074, the sender selects a PIN, and, in step 1076, agent terminal 402 via PDC 404 activates the card. In step 1078, a second card that is able to access the sender's card account is delivered to the beneficiary. The beneficiary, in step 1080, uses the card, and, in step 1082, the sender can reload the card account, allowing the beneficiary to continue making purchases and cash withdrawals.

In both of these discussions in Risafi that pertain to money transfers, the card to be employed by the recipient is actually activated before the recipient is involved in the process. With reference to Fig. 10C of the Risafi patent, the sender purchases the card and selects the pin in steps 1072 and 1074, respectively, and then the card is activated in step 1076. Next, in step 1078, a second card is delivered to a beneficiary and the beneficiary then uses the card in step 1080. The last disclosed step 1082 pertains to the sender reloading the card so that the recipient can withdraw more money by using the second card already in the recipient's possession.

Turning back to applicant's assertion, as discussed above, that it would not have been obvious to modify the Downing patent in the manner proposed by the Examiner, it is further submitted that one who reads and understands both the Downing and Risafi patents would be neither encouraged nor motivated to use Risafi's prepaid cards (or Risafi's disclosed steps of interacting with an agent that distributes card) within the system and process described in Downing. If Downing discloses a process that explicitly seeks to not employ electronic cards that are used to withdraw money from an ATM (or similar automated machine), and Risafi explicitly pertains solely to the implementation of an electronic card for various transactions,

why would it be obvious to combine these two references? Fundamentally, these references have contradictory objectives and, thus, one of ordinary skill in the art clearly would not find it obvious to combine their teachings in the manner proposed by the Examiner.

In the office action, the Examiner asserted that “It would have been obvious ... to modify the teachings of Downing to include the use of distributors presenting cards to recipients to access money dispensing terminals because it allows for a standard system in which money acquiring cards are issued to be integrated with transferring funds from one individual to another and simply lets the distributor act as an intermediary.” In response, the use of agents to distribute cards in the Risafi reference pertains to distribution of cards to the purchasers of such cards. Also, it is not clear why the Examiner’s purported reason to make the combination even supports the proposition that the combination is obvious. Turning again to the basic premise of the Downing patent, this patent seeks to enable money transfers without the use of cards. Thus, the combination is not obvious.

The Combination of Downing and Risafi Still Would NOT Produce Applicant’s Claimed Invention

Notwithstanding the above-assertion that it would not have been obvious to combine the teachings of Downing with the teachings of Risafi, it is further asserted that even if the teachings of these two references were combined, the results of such a combination still would not produce applicant’s claimed invention primarily since neither reference discloses various features claimed in the independent claims of the present application. In particular, neither reference discloses what the Examiner calls

the “intermediary steps of receiving [by the beneficiary] a money pick-up device from a distributor, and having that money pick-up device activated so that it may be used at a money-dispensing machine.” The Downing reference clearly does not disclose such steps, as acknowledged by the Examiner. Risafi also does not disclose such steps. As previously discussed, Risafi discloses that the purchaser of the pre-paid card (the consumer) actually obtains the money pick-up device (i.e., the ATM card) from a distributor (the agent) when the card is purchased. The reference clearly does not teach or otherwise disclose that an individual who is not the purchaser (e.g., a money-transfer recipient) picks up the card or other device from an agent or distributor. Rather, the only teaching in Risafi with regard to enabling another person to withdraw money is discussed above, where a second card is provided to such person. The reference states that the second card is provided to the recipient who can then withdraw money from the account. The Risafi patent does not teach that the recipient obtains that second card from a distributor (who activates that second card) after the recipient supplies some sort of password to the distributor. Nor would one of ordinary skill in the art have found this feature of applicant’s claimed invention obvious in light of any teaching in Risafi. Rather, one would clearly presume that the consumer purchasing the pre-paid card would also receive a second card that is then mailed by the consumer to the recipient. The consumer can then inform the recipient by telephone, e-mail, etc. of the pin number to use with the second card so that the funds can be withdrawn. This process is completely supported by the disclosure at col. 9, lines 51-57 of the Risafi patent, previously quoted (“...A transferor adds value to a card account, and a second card having access to the same account is delivered to

the transferee, perhaps in a different country. After the transferee learns of the PIN from the transferor, the transferee is then also able to access the value in the card account.”) Hence, when one of ordinary skill in the art combines the teachings of Downing with the teachings of Risafi, the resultant combination would not produce applicant’s claimed invention, but rather, at best, would modify the activities that occur upon depositing money by the customer, since Downing expressly teaches away from using an electronic card by the money transfer recipient.

Finally, with specific reference to the Examiner’s proposed modification of the steps that are carried out by the money transfer recipient in Downing by incorporation of a teaching set forth in Risafi (i.e., a recipient interacting with an agent distributing cards – office action, page 4, lines 7-9), there clearly is no support in the references, or in their cumulative teachings, that would make such a proposed combination “obvious.” The Federal Courts have been consistent in holding that the fact that one of ordinary skill in the art could have combined teachings of references in a particular way does not make the modification obvious unless the prior art suggests the desirability of the modification.<sup>1</sup> See *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q. 2d, 1397, 1398 (Fed. Cir. 1989). Based upon the respective teachings of Downing and Risafi, as discussed above, the prior art clearly does not suggest the desirability of, nor motivate nor encourage one of ordinary skill in the art in, modifying Downing in the manner proposed by the Examiner.

In view of the foregoing analysis, it is respectfully submitted that the combination of Downing and Risafi for the purpose of rejecting independent claims 1,

8, 14 and 18 is not proper. These claims are patentably distinct and unobvious over this prior art. It is requested that the rejection of claims 1, 8, 14 and 18 be withdrawn.

Since claims 2-7, 9-13, 15-17 and 19-23 depend from one of these independent claims, the foregoing discussion is equally applicable to the dependent claims and is believed to obviate the rejection of these claims.

Moreover, claims 2 and 9 recite further features that are neither disclosed nor suggested in the prior art. Claims 2 and 9 recite that the “activating step includes transmitting said unique device pick-up code from said distributor to said money-transfer company, and transmitting said personal code [“pin” in claim 9] from said money-transfer company to said distributor.” The Examiner asserts that Risafi discloses this feature at col. 4, line 61 – col. 5, line 10. Contrary to the Examiner’s assertion, this section in Risafi teaches that the PIN is selected and the selected PIN is communicated by the agent to the card processing center. The consumer can change the PIN if desired. The present invention however is a little more involved, wherein the beneficiary first supplies the “device pick-up code” to a distributor and, in response, the distributor activates a money pick-up device (recited in independent claims 1 and 8). Claims 2 and 9 further specify that the supplied device pick-up code is communicated from the distributor to the money-transfer company and, in response, the money-transfer company transmits the personal code (i.e., the PIN) to the distributor. Thus, it is the money-transfer company that designates the personal code of the money pickup device upon receiving the device pickup code. This is

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<sup>1</sup> See *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989).



quite distinct from the teaching set forth in the Risafi patent. Thus, claims 2 and 9 are further patentably distinct and unobvious over the prior art.

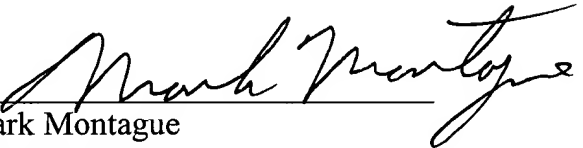
Claims 3-7 and 10-13 depend, either directly or indirectly, from claims 2 and 9, respectively, and thus are patentably distinct and unobvious over the prior art for the reasons discussed above.

Claim 15 depends from claim 14 and recites the use of automatic number identification (ANI). Claim 16 depends from claim 15 and recites validation means for matching an ANI signal with a previously stored telephone number of a distributor to validate a distributor's request to activate a money pick-up device. Claims 5, 6, 12 and 13 likewise recite these features. In the Office Action, the Examiner asserts that Risafi at col. 16, lines 11-32 discloses the features recited in Applicant's claims 15 and 16 (Office Action, page 5, lines 3-9). Contrary to the Examiner's assertion, this portion in Risafi does not refer to using an ANI signal and does not validate an agent's (distributor's) request. The referenced section in Risafi pertains to processing the purchase and activation of a telephone card, and selection of a PIN. Validation using ANI is not disclosed in the reference. Thus, claims 15 and 16 are further patentably distinguished and unobvious over the prior art.

New claims 24-29 are presented. For the reasons discussed above, it is submitted that these claims are patentably distinct, novel and non-obvious over the prior art. The allowance of claims 24-29 is solicited.

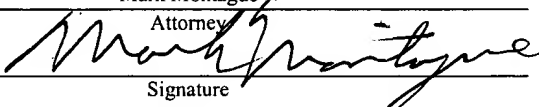
In light of the foregoing, reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

  
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